

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Case No. 07-1010-WO-US)

In the Application of:)	
)	
Rikki Peter Alexander)	
)	Examiner: Patricia L. Morris
Serial No.: 10/576,731)	
)	Group Art Unit: 1625
Filing Date: April 20, 2006)	
)	Confirmation No. 8274
For: Thieno-pyridinone derivative as)	
kinase inhibitors)	

PETITION UNDER 37 CFR 1.181 TO WITHDRAW FINAL REJECTION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The applicants petition to withdraw the finality of the Office Action mailed December 18, 2009, because it was improper.

The applicants submit that the examination procedure employed was faulty, being inconsistent with the legal examination requirements embodied in MPEP 803.02 guidelines for search and examination of Markush claims.

The applicants first present a summary of the relevant prosecution history, then an explanation as to why the examination in this case did not fulfill Office requirements.

File History Summary

On March 3, 2009, the Office issued a restriction requirement between the inventions of Group I wherein R1 and R3 are both non-heterocyclic groups, Group II wherein R1 and R3 contain a heterocycle, and Group III relating to method claims 11-25, and stated that applicants had to elect a single compound as the elected species for initial search purposes. In the response filed April 3, 2009, applicants acknowledged the restriction as to the Group III claims, withdrew the method claims, and traversed the restriction as to groups I and II. Applicants also elected for purposes of examination the species compound of Example 228, 3-benzoyl-7-(2,6-difluorophenyl)-2-[(1-methylazetidin-3-yl)amino]thieno[2,3-b]pyridine-6(7H)-one.

In the first Office Action on the merits mailed June 12, 2009, the Office maintained the restriction as to Groups I and II. The examiner stated that the application was examined with respect to the scope of claim elements R¹ and R³ consistent with the scope of Group I, and with a restricted scope of Group II, which had not been subject to the original restriction requirement. As to the merits, the sole rejections of the claims were under 35 USC 112 first paragraph with respect to the terms “solvates” and “optionally substituted,” and under 35 USC 112 second paragraph with respect to the terms “solvates,” “optionally substituted,” and “(C₃₋₇cycloalkyl)methyl.”

In the response filed September 8, 2009, applicants amended the claims to overcome the rejections as to the terms “solvates” and “optionally substituted,” and argued against the rejection as to “(C₃₋₇cycloalkyl)methyl.”

In the final Office Action of December 18, 2009, the restriction requirement was made final, and the stated scope of the examination was repeated. The rejection under 35 USC 112 second paragraph with respect to the term “(C₃₋₇cycloalkyl)methyl” was made final.

In a telephonic interview on January 6, 2010, the ground of rejection was discussed, and in the response filed January 14, 2010, applicants explained why the rejection as to the term “(C₃₋₇cycloalkyl)methyl” was improper.

In an Advisory Action mailed January 26, 2010, the Office stated that the January 14, 2010 response overcame the 35 USC 112 rejection, but that the application was not in

condition for allowance because the applicant had not cancelled the non-elected compounds or claims 11-25.

On February 8, 2010 applicants submitted an amendment in which claims 11-25 were canceled.

In an Advisory Action dated February 18, 2010 maintained the objection as to remaining claims 1-9 because of the failure to cancel the non-elected compounds.

Argument

The applicants respectfully submit that the search and examination procedure employed was inconsistent with Patent Office guidelines and deprived the applicants of their right to a full search of the claims. Therefore, the final rejection should be withdrawn and the claims searched to their full scope, with respect to the scope of the claim element R². Having found no prior art that invalidated the claim as limited even to what the applicants submit is an overly narrow construction of R² based on the provisionally elected species, the search should have been expanded to encompass the full scope of R².

The proper procedure for examining Markush claims is set forth in M.P.E.P. § 803.02:

A Markush-type claim may include independent and distinct inventions. ... In applications containing a Markush-type claim that encompasses at least two independent or distinct inventions, the examiner may require a **provisional** election of a single species prior to examination on the merits. ... Following election, the Markush-type claim will be examined fully with respect to the elected species and further to the extent necessary to determine patentability. If the Markush-type claim is not allowable, the provisional election will be given effect and examination will be limited to the Markush-type claim and claims to the elected species, with claims drawn to species patentably distinct from the elected species held withdrawn from further consideration.

As an example, in the case of an application with a Markush-type claim drawn to the compound X-R, wherein R is a radical selected from the group consisting of A, B, C, D, and E, the examiner may require a provisional election of a single species, XA, XB, XC, XD, or XE. The Markush-type claim would then be examined fully with respect to the elected species and any species considered to be clearly unpatentable over the elected species. If on examination the elected species is found to be anticipated or rendered obvious by prior art, the

Markush-type claim and claims to the elected species shall be rejected, and claims to the nonelected species would be held withdrawn from further consideration.

On the other hand, should the examiner determine that **the elected species** is allowable, the examination of the Markush-type claim will be extended. **If prior art is then found that anticipates or renders obvious the Markush-type claim with respect to a nonelected species,** the Markush-type claim shall be rejected and claims to the nonelected species held withdrawn from further consideration. The prior art search, however, will not be extended unnecessarily to cover all nonelected species. Should applicant, in response to this rejection of the Markush-type claim, overcome the rejection, as by amending the Markush-type claim to **exclude the species anticipated or rendered obvious by the prior art,** the amended Markush-type claim will be reexamined. The examination will be extended to the extent necessary to determine patentability of the Markush-type claim. In the event prior art is found during the reexamination that anticipates or renders obvious the amended Markush-type claim, the claim will be rejected and the action can be made final unless the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

(Emphasis added.) The applicants submit that following MPEP 803.02, a search of a Markush claim (which may include independent and distinct inventions) is to begin with the elected species and, if the species is allowable over the prior art, expanded to the full scope of the claims allowable over the prior art. The search may be stopped short of the full scope only if prior art is found that renders the claims unpatentable as anticipated or obvious; rejections under 35 USC § 112 are not a proper basis for limiting the search to the elected species. This is consistent with the policy of compact prosecution, which requires simultaneous examination of the claims as to all bases of patentability.

Because an improper search and examination procedure was employed and the applicants denied the search to which they were entitled, the applicants respectfully submit that the Office should withdraw the final rejection and search the claims to the scope permitted by the prior art, up to the full scope of the moiety R² as presented in the claims. Should prior art be identified, a non-final action would be appropriate to permit the applicants an opportunity to amend the claims and/or argue in favor of patentability. If the prior art rejection is thereby overcome, the search should be expanded once again, as is consistent with the example provided in MPEP § 803.02.

The applicants also request that any prosecution delays otherwise attributable to the applicant resulting from the improper imposition of the final Office Action be attributed to the Patent Office and that all extension of time fees necessitated by the improper imposition of the final Office Action be refunded to deposit account no. 13-2490.

Applicants respectfully advise the Commissioner that applicants are filing concurrently herewith a supplemental response to the pending Advisory Action which explains the same bases as to why the examination procedure followed herein is incorrect.

If there are any questions or comments regarding this application, the Examiner is encouraged to contact the undersigned in order to expedite prosecution.

Respectfully submitted,

Date: March 19, 2010

/Sandra B. Weiss/
Sandra B. Weiss
Registration No. 30,814

Telephone: 312-913-0001
Facsimile: 312-913-0002

McDonnell Boehnen Hulbert & Berghoff LLP
300 South Wacker Drive
Chicago, IL 60606